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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/986,762 | 11/09/2001 | Petter Ericson | 3782-0196P | 5644 |

2292 7590 11/29/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

TRAN, HENRY N

| ART UNIT | PAPER NUMBER |
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2674

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,762

Applicant(s)

ERICSON ET AL.

Examiner

HENRY N TRAN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 1-7, 10, 13, 14, 18-20, 25 and 30 is/are rejected.
- 7) ☒ Claim(s) 1-14, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is in response to the applicants' amendment received 4/7/04. The amendments to the claims have been entered. Claims 1-30 remain pending in this application. Applicants' remarks have been fully considered, with the results set forth as follows.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14, 27 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, which recites the limitation "the user unit" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 2-14, which are dependent claims of the base claim 1; and are therefore indefinite by virtue of their dependency of the independent claim 1.

For the purpose of this Office action, the examiner assumes that the above claimed limitation "the user unit" is changed to --the pen device--. Applicant is required to affirm or reverse this assumption in response to this Office action.

Regarding claims 27 and 29, which recites the limitation: "the user" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claims.

For the purpose of this Office action, the examiner assumes that the claimed limitation: "the user" recited in claims 27 and 28 is changed to --the pen device--. Applicant is required to affirm or reverse this assumption in response to this Office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 10, 13, 14, 18-20, 25, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al (U.S. Patent No. 5,661,506, hereinafter referred to as "Lazzouni") in view of O'Connor et al (U.S. Patent No. 6,188,392, hereinafter referred to as "O'Connor").

5. Regarding claims 1 and 18, Lazzouni teaches a system for information management, comprising a hand-held pen 10 having an imaging system 24 as means for recording a track of handwritten information in a digital format using the frame digitizing system 140 for storing in a coherent memory unit, which comprises a first memory unit 146 and a second memory unit 160 (a host memory) externally located in host computer 152; a communication interface 154 as means for transmitting the recorded information from a first memory unit 146 to a second memory unit (see figures 1 and 10; col. 4, lines 37-50; col. 8, line 59 to col. 9, line 29). However, Lazzouni et al do not shows expressly that the first memory unit is located in the hand-held pen 10; and the recorded information can exceed the storage capacity of the first memory

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unit. O'Connor et al teach an information management system for writing and recording handwritten information comprising a pen 100 having a memory unit 120 and a personal computer PC 130 that acts as a network server; wherein, the pen comprises an internal memory 120 whose storage capacity can be afforded to stored accumulated pen data over a certain period of time, e.g. a day, for transmitting to the PC; see figures 1 and 2; col. 1, lines 52-54. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of O'Connor et al discussed above in the Lazzouni et al device because this would provide an improved compact pen input device, which has a memory for conveniently and effectively recording pen input information for transmitting to a computer, and which is autonomous and easily to use, see col. 1, lines 48-55 and col. 5, lines 58-64. By this rationale, claims 1 and 18 are rejected.

6. Regarding claims 2-7, 10, 13, 14, 19, 20 and 25, Lazzouni et al further teach: information includes absolute position information, which is transferred using a predetermined rules provided by a frame processing system 142, see col. 4, line 19; the imaging system 24 comprises an imaging sensor 52 for optical recording a position code on encoded paper base 14, see col. 5, line 42; and col. 6, line 5; the transmission means 154 is arranged only for data transfer to the host computer 152 when a data transfer is desired, see col. 5, lines 17-27.

O'Connor et al further teach: the use of a wireless interface 119 for transmitting pen data, see references recited above; and subsets of the pen data can be transmitted, see col. 6, lines 16-22. Official notice is taken for the claim term "an address for the information" because memory utilizes addresses for defining memory locations for storing data, and that is old and well-know in the art of memory addressing. Claims 2-7, 10, 13, 14, 19, 20 and 25 are dependent upon base

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claims 1 and 18, and are therefore rejected on the same reasons set forth in claims 1 and 18, and by the reasons discussed above.

7. Regarding claim 30, which is a method claim corresponding to the apparatus claims 1 and 2, and are rejected on the same basis set forth in claims 1 and 18 discussed above.

Allowable Subject Matter

8. Claims 15-17 and 26-29 are allowed.

9. Claims 8, 9, 11, 12 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments filed 4/7/04 have been fully considered; and have overcome the rejections of claims 8, 9, 11, 12, 15-17, 21-24 and 26-29.

11. Applicant's arguments regarding to claims 1-7, 10, 13, 14, 18-20, 25, and 30 have been fully considered but they are not persuasive because of the following reasons:

- Firstly, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "automatically transferred", and "the recorded information will never exceed the storage capacity of the internal memory of the pen") are not recited in the rejected independent claims 1, 18 and 30. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993);

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- Secondly, O'Conner's reference is relied upon for the teachings: the pen 100 comprises a memory 120, which is located within the pen 100; the storage capacity of the pen memory 120 is limited; and an autonomous pen input device is desired, see the references recited above; and
- Finally, the motivation to combine the teachings of Lazzouni with O'Conner has been rewritten, and is provided in the paragraph 5 discussed above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. They are U.S. Patents Nos.: 6,292,181 and 5,729,251, which teach pen-computer interfaces.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed **within TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

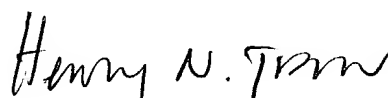
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to HENRY N TRAN whose telephone number is 703-308-8410.

The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD A HJERPE can be reached on 703-305-4709. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HENRY N TRAN
Primary Examiner
Art Unit 2674

11/28/04